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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,138	02/08/2001	Toshiyuki Nakao	116692000300	1451
25227	7590	05/18/2006	EXAMINER	
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			ZAND, KAMBIZ	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/779,138	NAKAO ET AL.
	Examiner	Art Unit
	Kambiz Zand	2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on RCE filed on 03/31/2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-6, 15, 18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2-6, 15, 18 and 20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 February 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



KAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/31/2006 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
3. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
4. Claims 1, 7-14, 16-17, 19 and 21 have been cancelled.
5. Claims 2-6, 15, 18 and 20 have been amended.
6. Claims 2-6, 15, 18 and 20 are pending.
7. Claims 7-13, 16-17, 19, and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 01/11/2005.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

9. **Claim 20** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Limitation "embodied in a carrier wave" declares patentability consideration with respect to a signal that is not tangible and therefore, is nonstatutory under 35 U.S.C. 101. See *In re Warmerdam*, 33 F.3d 1354;31 USPQ2d 1754. See MPEP § 2106 IV. B. 1. See <http://www.uspto.gov/web/menu/pbmethod/> (35 U.S.C. 101 Training Materials).

10. **Examiner suggests cancellation of claim 20 or replacement of the limitation "A computer data signal embodied in a carrier wave" with the limitation "An apparatus".**

11. If Examiner's suggestions with respect to either cancellation of claim 20 or deletion of the limitation "A computer data signal embodied in a carrier wave" would not acceptable to the Applicant, then the better course of action for **traversing the 101 issues would be an appeal before the board of appeal and Interference.**

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) patent may not be obtained though the invention is not identically disclose or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 2-6, 15, 18 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sick et al (2003/0216971 A1).

Applicant's limitation are broad enough that any environment that deals with the usage of a device would read on the limitations since the usage of a device is not specified. Although Examiner have used Sick's reference to deal with the limitations, any version of Novel, Unix and Microsoft operating systems has such capabilities build in their software for Administrator of the network that monitors all aspect of network security and usage of the device and user's access rights. Examiner suggests any amendments be considered as the above software features in addition to the references used below. Also be aware that the patentability is based on the Novelty and Inventive steps, but not on intended use (see below) or a design choice. the limitations as it is written mainly deal with a business method solution than an inventive steps or a novelty dealing with classes 713; 380 and 726.

Examiner strongly suggests that the focus of Applicant's claimed invention on page 2, lines 11-15 and 20-23 of the specification be present in the independent claim language in a manner that is distinct over the prior arts if possible.

As per claim 3 Sick et al (2003/0216971 A1) teach a system for managing a networked office automation device arranged and networked in a workplace (see abstract; fig.2 and associated text; [0010-0011]), comprising: verification means for verifying operation of the office automation device by a verified user in the work place (see [0031-0033];[0036], information acquisition means for acquiring device usage information including a value indicating an amount of usage of the office automation device by the verified user in the work place (see [0036-0037][0100][0107] where the table 2i of fig.2 stores Ids to all meters associated with a customer that corresponds to Applicant's verified user recording the usage amount of the corresponding device), information acquisition means for acquiring device usage information including a value indicating an amount of usage of the office automation device by the verified user ([0107][0036]), information storage means for sequentially storing the device usage information acquired by the information acquisition means ([0106-0111]); amount acquisition means for acquiring a usage amount record of the office automation device based upon device usage information stored in the information storage means ([0107-0112]), comparison means for comparing the usage amount record and a reference value and producing a comparison result, and output means for outputting the comparison result ([0021][0022][0032][0095 with respect to capability for outputting the result having I/O devices].

It would have been obvious to utilize Sick's management of the devices in a energy monitoring which mainly deals with power consumption and analysis to include other

specific usage of each device in a network in terms of life of a device, amount of usage of each interface as Sick paragraph [0032-0033-0021-0022] discloses.

A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)).

As per claims 15, 18 and 20 Sick et al (2003/0216971 A1) teach a method, a computer program for executing a method of managing use of a networked office automation device arranged and networked in a work place, the method comprising: verifying a user in the work place operating the office automation device, obtaining an amount of usage of the office automation device made by the verified user operating the office automation device, acquiring usage information of the office automation device comprising the obtained amount of usage of the office automation device, storing the acquired usage information in a database, processing the usage information stored in the database, and based on a comparison of the amount of usage and a reference value, sending a message corresponding to a comparison result to at least one of user of the office automation device and an administrator of the office automation device. It would have been obvious to utilize Sick's management of the devices in a energy monitoring which mainly deals with power consumption and analysis to include other specific usage of each device in a network in terms of life of a device, amount of usage of each interface as Sick paragraph [0032-0033-0021-0022] discloses.

A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)).

As per claim 2, 4 and 6 Sick et al (2003/0216971 A1) disclose all the limitation as applied above. [0107] deals with metering which corresponds to applicant's counting an amount of usage in claim 2; identification of the user is being done by the match of the ID with the device that corresponds to the customer in claim 2; storage means and different tables and databases of the figures in Sick corresponds to user information, device information, usage information, amount of the usage, etc. other limitations in the claims 2, 4 and 6 are similar to limitations of the independent claims stating in different lexicon and therefore rejected as applied to independent claims above.

It would have been obvious to utilize Sick's management of the devices in a energy monitoring which mainly deals with power consumption and analysis to include other specific usage of each device in a network in terms of life of a device, amount of usage of each interface as Sick paragraph [0032-0033-0021-0022] discloses.

As per claim 5 Sick et al (2003/0216971 A1) teach all the limitations since it is only for intended use and repeat of the process already addressed in the independent claims. It would have been obvious to utilize Sick's management of the devices in a energy monitoring which mainly deals with power consumption and analysis to include other

specific usage of each device in a network in terms of life of a device, amount of usage of each interface as Sick paragraph [0032-0033-0021-0022] discloses.

A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Please see enclosed PTO-892.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KAMBIZ ZAND
PRIMARY EXAMINER

05/08/2006

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